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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/574,491	04/03/2006	Yukio Yoshida	287412US0PCT	2353
22850	7590	10/25/2010		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER				
VASISTH, VISHAL V				
ART UNIT		PAPER NUMBER		
1771				
NOTIFICATION DATE		DELIVERY MODE		
10/25/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/574,491

Applicant(s)

YOSHIDA ET AL.

Examiner

VISHAL VASISTH

Art Unit

1771

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13 and 22-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 and 22-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicants' response filed on 8/10/2010 amended independent claim 9, cancelled claims 1-8 and 14-21 and added new, dependent claims 23-34. Applicants also amended dependent claims 13 and 22 but these amendments did not change the scope of the claims. Applicants' amendments traverse the 35 USC 102 rejections over Vojacek and Osawa and the 35 USC 103 rejection over Vojacek in view of Osawa from the office action mailed on 5/10/2010 and therefore these rejections are withdrawn.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

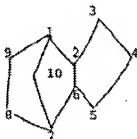
3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 9-13 and 22-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vojacek et al., EP Publication No. 0082967 (hereinafter referred to as

Vojacek) in view of Wygant, US Patent No. 3,803,037 (hereinafter referred to as Wygant).

Vojacek discloses traction drive fluid compositions comprising a mixture of hydrocarbons including tricyclo [5.2.1.0^{2,6}] decane represented by the formula (which reads on claim 1) (Page 8):



and cyclopropane-[1-spiro-2]-norbornane and 4,8, 8-Trimethyl-9-formyl-decahydro-1, 4-methano-azulene (Page 5, paragraph 4). It is the position of the examiner that since Vojacek discloses the hydrocarbon recited in instant claim 1 that the hydrocarbon inherently has a viscosity at -40°C of 30 Pa·s or lower and a viscosity index of 80 or higher.

Vojacek further discloses additives that can be present along with the hydrocarbons disclosed above and include antioxidants, antifoaming agent, dispersing agent, viscosity index improver and extreme pressure additives (as recited in claim 13).

Vojacek discloses all of the limitations discussed above including an alicyclic base oil used in combination with the other traction base oils. Vojacek does not explicitly disclose the base oil reading on formula (h) of claim 10.

Wygant discloses a traction drive fluid composition (Col. 2/L. 5-7) comprising base oils including 2,4-dicyclohexyl-2-methylpentane and 2,3-dicyclohexyl-2,3-dimethylbutane (as recited in claims 10-12) (Col. 2-3/L. 47-10). It would have been obvious to one of ordinary skill in the art at the time of the invention to use the alicyclic base oils of Wygant in the composition of Vojacek because of their good lubricating properties and relatively high coefficient of frictions (Col. 2/L. 22-24 of Wygant).

Response to Arguments

5. Applicants' arguments filed on 8/10/2010 with respect to claims 9-13 and 22-34 have been considered but are moot in view of the new grounds of rejection.

Applicants argue that Wygant does not disclose the cyclohexyl compound with any sort of preference or specificity. This argument is not persuasive. It is the position of the examiner that although 2,4-dicyclohexyl-2-methylpentane and 2,3-dicyclohexyl-2,3-dimethylbutane are mentioned within a list of cyclohexyl compounds that one of ordinary skill in the art would look to use these compounds as traction drive lubricants because of their high traction coefficients and good lubricating properties with a reasonable expectation of success (Col. 2/L. 22-24). Also, the entire disclosure of Wygant should be examined and not simply the preferred embodiments when considering whether or not the recited claims are rendered obvious by the prior art reference, i.e. Wygant.

Applicants further contend that their claimed formulations demonstrate unexpected results. This argument is also not persuasive. In order to demonstrate

unexpected results, the formulations must possess a property that was surprising or unexpected. This is not the case with the present application wherein several of the comparative examples also have high traction coefficients and good viscosity such as comparative example 3 from table 1-2 of the instant specification.

Furthermore, the claims need to be commensurate in scope with the data provided. Formulae (a)-(f) are not all represented in the example formulations and when present in the example formulation are present in specific concentration with the dicyclohexyl compounds represented by formula (h) in the instant claims which are also present in specific concentrations. Also, the example formulation use viscosity indexes and low temperature viscosity measurements that are much more narrowly defined than what are represented by the instant claims.

Finally, in order to demonstrate unexpected results, applicants must compare their formulations to those of the closest prior art reference(s). Applicants have not done so in the instant application. The reasons discussed above indicate why applicants have not demonstrated unexpected results across the full scope of the claims.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VISHAL VASISTH whose telephone number is (571)270-3716. The examiner can normally be reached on M-R 8:30a-5:30p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571)272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

Art Unit: 1771

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VVV

/Ellen M McAvoy/
Primary Examiner, Art Unit 1797